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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,567	06/20/2003	Graham Hume	PINE-001	9640

7590 03/08/2006

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EXAMINER

DIXON, MERRICK L

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/600,567

Applicant(s)

HUME, GRAHAM

Examiner

Merrick Dixon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 10-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


MERRICK DIXON
PRIMARY EXAMINER

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richards et al(US 6306317 B1).

The cited reference teaches the basic claimed process including creating water based slurry of boron salts, adhesive material and mixing them together to form a fire retardant material- col 1, lines 50-60; col 9, lines 59-67; col 11, lines 58-65. It is submitted the mixtures would be independently added together, during the cited patent's process ,in the absence of unexpected results. Concerning claims 2,6-9, it is submitted the formed product, including its density, strength, w/w characteristics and compliance, i.e., types material used, are limitations directed to article limitations and are of no patentable consequences to the instant question for patentability which must be manipulatively distinct. It is submitted, however, such product properties would have been obvious if not taught and in the absence of unexpected results. Concerning claim 3, the reference teaches adding numerous material in its mixtures during the patented process- see above. The reference teaches ph manipulations- col 3, lines 29-45. as required by claim 4. It is submitted the boron particle sizes would inevitably decrease during their suspension in the aqueous universal solvent, water . This would be expected as required by claim 5.

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Applicant's arguments filed 12-23-2005 have been fully considered but they are not persuasive. Applicants argue that the cited Richards reference fails to teach specific

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types salts. Applicants further argue the cited reference teaches fire-retardant composition in aqueous form. Not slurry form as claimed. Applicants next argue that the reference thus teaches away from the claimed invention because same reference does not teach suspended particles. To the above, the examiner respectfully remind applicants that the germane limitations are manipulative steps. Not the article limitations argued by applicants. The cited reference indeed teaches the manipulative steps as claimed and thus articulated in the office action. Applicants finally argue that the reference further fails to teach adding specific types material into the composition and that the reference teaches mixing the adhesive and fire retardant before applying it to a substrate. The examiner disagrees. It is not apparent to the examiner why such aspect of premixing the material , then applying the mixture to a substrate makes the claimed invention unobvious over the cited art of record. The cited reference teaches mixing its material together. It teaches the step of applying the mixture to a substrate. It is submitted any reversal of the steps would have been obvious , in the absence of unexpected results . Applicants have failed to show why such reversal is novel. The examiner respectfully remind applicants that the office is in no position to determine experimentally whether or not, in a process such as tht at issue, the subject matter known is the same as that known in the prior art. Accordingly, in such instances, this shifts the burden to the applicants who have the resources to make a clear distinction and to better experimentally define the differences between the teaching of the reference and th claimed invention.

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This application contains claims 10-34 drawn to an invention nonelected with traverse in Paper No. 6-13-05. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Applicants who wish to send a facsimile (draft copies) for the examiner's immediate review can do so by using the Examiner's personal fax number at 571-273-1520. The faxing of all papers must conform with the notice published in the Official Gazette, 1096 O.G. 30 (November 15, 1989). **NOTE: All facsimiles sent to the examiner's**

personal fax number should be in draft-forms and will be treated as informal.

Same facsimiles will not be entered in the related applications unless otherwise agreed and noted by the examiner.

The fax number for all other fascimile is 571-273-8300.

Information about **the status of an application** may be obtained from the Patent Information Retrieval system (**Private PAIR**).

Status inquires for **published applications** may be retrieved from either **Private PAIR** or **Public PAIR**. Questions about the PAIR system should be directed to the Electronic Business Center at **866-217-9197**.

Any questions concerning the instant communication should be directed to Examiner Dixon, at 571-272-1520, Mondays, Wednesdays and Thursdays, between 12 noon and 8 PM, eastern time .

A handwritten signature in black ink, appearing to read 'Merrick Dixon', with a stylized, flowing script.

Merrick Dixon

Primary Examiner

Group 1700